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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,398	04/11/2000	Hiroshi Satomi	862.C1893	4944

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NEW YORK, NY 10112

EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

28

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/547,398

Applicant(s)

HIROSHI SATOMI

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 26.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Information Disclosure Statement**

1. The information disclosure statement filed reference listed in the information disclosure submitted on 06/04/04, have been considered by the examiner (see attached PTO-1449).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. **Claims 29-30, 32, 34-37**, are rejected under 35 U.S.C. 102(e) as being anticipated by Skillen et al. (US Patent Number 6,098,065).

Regarding **claims 29-30, 35-37**, Skillen teaches a method/an information provider system/a program product/a computer-readable memory medium 30 for requesting outputting content information stored in a database 48 network (Internet) (col 3 lines 50-65, col 5 lines 60-63) comprising:

the database 48 on the network, for storing content information corresponding to an identification code (user ID)(see figure 2, col 6 lines 39-57, col 6 lines 4-12);

a client communication terminal 12 comprising an extraction unit (search engine 40/Key Pad) comprised single physical key for extracting an identification code (user Id's)form data and a transmitting the extracted identification code to a server terminal (col 5 lines 58-67, col 6 lines 1-12);

an acquisition unit 40 (search engine) for content information corresponding to the transmitted identification code from the database 48(col 5 lines 29-34, lines 63-67, col 6 lines 1-3); and

an output unit (PC, window) 12, connected to the server terminal 38 totally, for outputting the acquired content information (col 5 lines 18-28, col 6 lines 27-28).

Regarding **Claim 32**, Skillen teaches a system wherein the extraction unit extracts the identification code (user's Id) for a plurality of the data at once (col 5 lines 39-45, lines 64-67, col 6 lines 1-12).

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Regarding **Claim 34**, Skillen teaches a system according wherein the client communication terminal 12 further comprising:

a storage 30 unit arranged to store the extracted identification code (user's Id or sire address or advertisement Id's) in a memory 30 (see figure 2, col 5 lines 40-56), the databases 42/48/46 are used for storing the information; and

a selection adapted to, after the information identification code (advertisement identification) is transmitted by the transmission unit 44 (col 5 lines 17-25), select whether or not the information identification code stored in the memory is to be erased (col 6 lines 26-35). Continually updating of the advertisement 's product showing the possibility of erasing the Identification of the information.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 31, 33**, are rejected under 35 U.S.C. 103(a) as being unpatentable over by Skillen et al. (US Patent Number 6,098,065).

Regarding **Claim 31**, Skillen fails to teach a system wherein the data is mail data in which the identification code is described. However, the examiner takes official notice that a system that a data is a mail data is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine

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above teaching with Skillen system, in order to provide a more variety to the system by providing mail to the user as well as the other information.

Regarding **Claim 33**, Skillen teaches a system according wherein the data in which the identification code (user's Id) is described, wherein the client communication terminal 12(PC) further comprises a display (See figure 2, col 4 lines 64-67) for displaying the data, and the identification code (user's Id) is displayed by another form which is different from character strings excluding the identification (col 4 lines 64-67, col 5 lines 1-11, liners 20-38). Skillen fails to teach a system wherein the data is mail data in which the identification code is described. However, the examiner takes official notice that a system that a data is a mail data is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching with Skillen system, in order to provide a more variety to the system by providing mail to the user as well as the other information.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 29-37 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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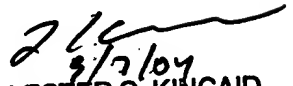
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid be reached on (703) 306-3061.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
3/7/09  
LESTER G. KINCAID  
PRIMARY EXAMINER